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10/732,726

12/10/2003

William T. Ball

5564-152

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10/25/2010

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EXAMINER

FETSUGA, ROBERT M

ART UNIT

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3751

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10/25/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/732,726 | Applicant(s) BALL, WILLIAM T. | |
| | Examiner Robert M. Fetsuga | Art Unit 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/19/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The telephone interview requested by applicant, pursuant to form PTOL 413A filed September 13, 2010, was conducted on September 22, 2010. The interview participants were applicant's representatives Joe Kovarik and Craig Mueller, and the examiner. Applicant's representatives discussed the similarities between the pending claims, and the patented claim of applicant's 6,675,406 patent ('406). Generally, this discussion paralleled the positions stated in the instant response, also filed September 13, 2010, as presented under the heading "NEW CLAIMS". In addition, the examiner questioned the disclosure support for the specification amendment filed with the response. Specifically, the examiner was unable to find any discussion in the original specification, or in the response, concerning the "configured to completely conceal" feature associated with the cap 96 which was proposed to be added by the amendment. The examiner reasoned that an overflow cap would normally allow fluid access to the overflow pipe after the cap was installed over the overflow port. In explanation, applicant's representatives pointed to the rectangular box on the face or surface of the cap 96, illustrated in Fig. 4 of the instant application, as permitting such fluid flow.

2. The amendment filed September 13, 2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the

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disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The addition to page 7 concerning the "configured to completely conceal" feature is considered to be new matter. The original disclosure does not present any size description of the cap 96 relative to the nut 90 when the cap is in an installed position. The examiner acknowledges that, given the relative size depictions in Fig. 4, the flange of the cap 96 could completely cover the nut 90, per se, when engaged thereover. However, in the installed configuration of the overflow assembly, the threaded portion 66,68 of the overflow port 62 could extend inwardly of the tub end wall 24 such that the cap would be prevented from completely covering the nut. Furthermore, even though the cap 96 could be sized to account for such a tub sidewall thickness and thread extent, as is evident from the '406 patent and the cap 78 depicted therein (Fig. 4), the cap 78 of '406 also includes a notch 80 in the cap flange 76 to allow fluid flow. In this regard, the notch 80 would preclude complete concealment.

Applicant is required to cancel the new matter in the reply to this Office Action.

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3. Claims 28 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the subject matter considered to be new matter, as discussed above.

4. Claims 28 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites a surface "configured to completely conceal said nut". Claim 39 recites similar subject matter. Considering the recited "surface" to be the face of the cap 96 absent the flange, the claim limitation does not make sense. Clearly, such a surface, per se, could not function for completely concealing the nut. The metes and bounds of the claim recitation is not ascertainable.

5. The declarations of Bill Carlson and William T. Ball, as filed with the response, are considered effective to remove the Fritz et al. '531 patent as available prior art in the instant application.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-15, 21-30 and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over CH 346187, Ball '241, Rosenbaum, and Holt et al.

The CH 346187 (Gebert) reference discloses an overflow assembly, as set forth in claims 11-14, 21-30 and 32-39, except for the provision of a diaphragm, and for the cap being engaged directly with the nut. Re claim 28, the surface of the cap 14 (absent the flange at 21) in Gebert would appear to function for completely concealing the nut, in the same sense as with applicant's disclosed invention.

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The Ball '241 reference teaches (cols. 2-3) a method of testing a plumbing system where an outer end of an overflow pipe is closed with a diaphragm 64, the system is tested, and then the overflow pipe is opened by cutting the diaphragm. It would have been obvious to one of ordinary skill in the art to perform a plumbing test, as taught by Ball '241, on the Gebert plumbing system, in order to determine system integrity. Re claim 32, the choice of plastic as the material of composition for the diaphragm would appear an obvious choice to be made where Ball '241 teaches "flexible rubber or the like" (col. 2, ln. 36), and Gebert teaches that polyethylene plastic is elastic (pg. 3, lns. 4-5).

Although the Gebert cap 14 is not engaged directly to the nut 8, as claimed, attention is directed to the Rosenbaum reference which teaches that a nut cap is often provided to enhance the decorative appearance of the nut (col. 1, lns. 18-23). Moreover, Rosenbaum teaches a direct engagement between a cap 30 and a nut 12 via a plurality of lugs 14 on the nut (col. 3, lns. 18-28). It would have been obvious to one of ordinary skill in the art to engage the cap of Gebert directly to the nut as being an art recognized equivalent connection scheme to the retaining ring 10 securement scheme in Gebert. The Holt et al. (Holt) reference is cited here as evidence that an overflow cap

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of the type disclosed by Gebert does function for appearance purposes. See Holt at column 1, lines 46-52. Lastly, to the extent the nut disclosed by Gebert does not include radially extending lugs, such as those normally formed between hexagonal-patterned flats, Rosenbaum also evidences the common configuration of such a nut as discussed in the paragraphs bridging columns 2 and 3.

Re claim 15, Ball '241 also teaches (Fig. 2) that a conventional plumbing system of the type disclosed by Gebert often includes a vent pipe 40 and interconnecting pipe 42.

Applicant's arguments at pages 11-17 of the response have been considered, but are deemed moot in view of the newly cited evidence. The previously applied Espey et al. (Espey) reference was relied upon for teaching that use of a decorative cap to enhance the appearance of an exposed nut is a well established concept, and that engagement of such a cap to a nut via lugs is one type of connection scheme. Even though Espey further teaches a preferred embodiment/use involving a bicycle, the examiner is required to consider prior art disclosures for all that they contain. See MPEP 2123. In any event, the newly cited Rosenbaum reference better addresses the new claim limitation(s) concerning a direct engagement between a decorative cap and lugs of a nut.

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8. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert, Ball '241, Rosenbaum, and Holt, as applied to claim 11 above, and further in view of Ball '931.

Although the Gebert bathtub plumbing system may not include a drain pipe, lock washer and drain closure, as claimed, attention is directed to the Ball '931 reference which discloses an analogous bathtub plumbing system which further includes a drain pipe, lock washer and drain closure (col. 1, lns. 8-24). Therefore, in consideration of Ball '931, it would have been obvious to one of ordinary skill in the bathtub plumbing system art to associate a drain pipe, lock washer and drain closure with the Gebert bathtub plumbing system as being a common type of bathtub plumbing system. Furthermore, Ball '241 teaches plugging the drain port of a bathtub plumbing system during hydraulic testing "in any convenient manner" (col. 2, lns. 59-60), and further teaches use of a diaphragm 64 to accomplish such plugging (col. 2, lns. 37-40 and col. 2, ln. 65 thru col. 3, ln. 13).

Applicant has not substantively argued this ground of rejection beyond noting claim dependency.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert, Ball '241, Rosenbaum, and Holt, as applied to claim 24 above, and further in view of Delanoy et al.

The choice of diaphragm securement would appear an obvious choice to be made. The Delanoy et al. (Delanoy) reference teaches connecting a plumbing test diaphragm 10 to a plumbing fitting via being integrally formed with the fitting. Note page 1, lines 59-62 in Delanoy.

10. Applicant's general remarks at pages 9 and 18 of the response, that pending claims 24 and 36 are allowable because they recite similar limitations to those previously found allowable by the examiner during prosecution of Ball '406, are noted. The examiner disagrees with applicant's position for two reasons. First, the lug and cap engagement feature of the '406 patent differs significantly from the lug and cap engagement feature of the instant CIP application. Secondly, the overflow port claimed in the '406 patent includes both a sleeve feature and a hollow fitting feature. These two features are not in the disclosure of the instant CIP application. As a result, the pending claims define an invention different than the invention of the '406 patent.

11. The grounds of rejection have been reconsidered in light of applicant's arguments, but are still deemed to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

/Robert M. Fetsuga/
Robert M. Fetsuga
Primary Examiner
Art Unit 3751